

Docket No. E20240-USORD
Serial No. 10/803,748

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claims 1-17, 19-26, 28-31, 34-36, 38-39, 41, 43-45, and 47-49 are pending in this application.

Rejection under 35 USC § 103(a)

Claims 1-7, 11-17, 19-26, 28-31, 34-36, 39, and 43-45 are rejected under 35 USC § 103(a) as allegedly defining obvious subject matter over U.S. Pat. No. 4,614,450 to Neiman in view of U.S. Pat. No. 5,080,223 to Mitsuyama, and further in view of U.S. Pat. No. 4,345,394 to Sullivan. Claims 1, 7, 8-10 are rejected as allegedly defining obvious subject matter over U.S. Pat. No. 6,652,178 to Walton in view of Mitsuyama in view of Sullivan and further in view of U.S. Pat. No. 3,720,304 to Laugherty. Claims 1, 19, 29, 34, 38, and 41 are rejected as allegedly defining obvious subject matter over U.S. Pat. No. 6,652,178 to Walton in view of Mitsuyama in view of Sullivan. Claims 47-49 are rejected as allegedly defining obvious subject matter over U.S. Pat. No. 6,652,178 to Walton in view of Mitsuyama in view of Sullivan and further in view of U.S. Pat. No. 3,720,304 to Laugherty.

Claims 1, 19, and 29 cover a storage sheet having at least "two card pockets positioned thereon, each card pocket being differently sized to closely receive differently sized index cards therein; and where said plurality of index cards includes two differently sized index cards, wherein each index card is sized to be closely received in a corresponding one of said card pockets."

The Examiner recognizes that none of the cited references teach or suggest that the storage sheet has at least two card pockets, wherein each card pocket is differently sized to closely receive differently sized index cards therein, as shown in claims 1, 19, and 29. The Examiner instead attempts to rely on an argument that the sizing of the card pockets and index cards is an obvious matter of design choice, as per *In re Rose*, 105 USPQ 237 (CCPA).

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However, there are multiple problems associated with the application of such case law:

1) In re Rose (see MPEP 2144.04(IV)(A)) is not specifically directed, e.g., to choosing one element to be one size and another element to be a second size. Instead, in that case,

claims "directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art."

Thus, In re Rose does not at all address the obviousness of simultaneously employing different sized elements. In particular, in the "In re Rose" case, there was no consideration made to change the size of some lumber packages but not others and/or to change the respective size of different packages to different degrees. Essentially, the fact situation presented by the present claims is more complex than that of In re Rose. Thus, the judicial teaching provided by In re Rose is unable to overcome the shortcomings associated with any of the various combinations of applied art, with respect to independent claims 1, 19, and 29.

2) As per MPEP 2144, it is held that if "the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." With respect thereto, in Paragraph [0023] of the present specification, it is stated that:

"pocket 15 may have dimensions roughly similar to the dimensions of a full size index card 55 and pocket 20 may have dimensions roughly similar to the dimensions of a half-size index card 56 such that each of the pocket 15, 20 can closely receive a full size 55 and half-size 56 index card therein, respectively."

Thus, in Paragraph [0023] Applicants clearly establish the criticality of providing different size pockets, i.e., to expressly accommodate different size index cards. (In the Final Office Action, the Examiner repeatedly indicated that Paragraph [0021] points to a lack of criticality of the pocket size, but that paragraph does not even mention pockets 15, 20.) Further, the provision of multiple size pockets addresses the need for easy storage of

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index cards, as covered in Paragraphs [0002] and [0003]. Accordingly, Applicants submit that it is improper to rely solely on case law as the rationale to provide for different size card pockets, as covered in independent claims 1, 19, and 29.

For the foregoing reasons, the applied prior art, taken alone or in combination, in concert with known case law, fails to anticipate or render obvious the subject matter of independent claims 1, 19, and 29. Accordingly, Applicants submit that claims 1, 19, and 29, along with those claims depending therefrom, are now in condition for allowance, the allowance of which is hereby respectfully requested.

Conclusion

Applicants believe that the present application is in condition for allowance. Favorable consideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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If any fees are due in connection with the filing of this Amendment, please charge the fees to 132512. If a fee is required for an extension of time under CFR § 1.136 that is not accounted for above, such an extension is requested, and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

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